

REMARKS

**Status of the Claims**

Claims 1, 7-9, 22, 23, 25 and 34 are currently pending in the application. Claims 1-9, 22, 23, 25 and 34 stand rejected. Claims 2-6, 10-21, 24 and 26-33 have been cancelled without prejudice or disclaimer in the Reply of February 23, 2007. This Supplemental Amendment is submitted to enter a Declaration under 37 C.F.R. § 1.131 into the record. Reconsideration is respectfully requested.

In addition to Applicants' response of February 23, 2007, the entire contents of which are incorporated herein by reference, in reply to all outstanding issues and rejections, Applicants additionally submit the following comments for the Examiner's consideration in response to the outstanding Office Action of April 24, 2006.

Applicants submit herewith a Declaration under 37 C.F.R. § 1.131 antedating the reference Taipale et al., GenBank Accession Number AF337549, February 2, 2002. The Declaration further clarifies the inventive roles of the present Inventors with respect to the presently claimed subject matter.

That is, though Jaana Nopola-Hemmi and Nina Kaminen are not listed as authors on the Taipale et al. reference, Jaana Nopola-Hemmi and Nina Kaminen are properly named inventors. U.S. legal precedent holds that to be considered an inventor, a person must contribute to the conception of the invention. (*See, Fritsch v. Lin*, 21 U.S.P.Q.2d 1731, 1736, Bd. Pat. App. Int., 1991, stating "in this case it has been determined in considering the question of prior inventorship that knowledge of correct EPO amino acid sequence information and precise procedures for isolating the EPO gene are critical aspects of conception with respect to the

invention at issue. These are the very components of the invention to which Hewick and Jacobs are said to have contributed.”).

Jaana Nopola-Hemmi and Nina Kaminen contributed to the conception of the present invention by determining, along with Juha Kere and Mikko Taipale, in determining that the DYXCI gene plays a role in dyslexia. Determination of a use or utility for a chemical compound is required for conception, especially when the use or utility of an invention is not readily obvious to one of ordinary skill in the art. (*See, D'Amico v. Brown*, 155 U.S.P.Q. 534, 537-538, Bd. Pat. App. Int., 1967, stating, “a conception must be complete and operative the absence of any indication of a use is fatal to the case for Brown et al.” citing *Mergenthaler v. Scudder*, 11 App. D.C. 264, 1897 C.D. 724, D.C. Cir. 1897; and *Biel v. Chessin*, 52 C.C.P.A. 1607, 347 F.2d 898, 820 O.G. 1771, 146 U.S.P.Q. 293, C.C.P.A. 1965, *see also, Rey-Bellet v. Englehardt*, 181 U.S.P.Q. 453, 456, C.C.P.A., 1974, stating, “conception of that invention is not complete absent a conception of its utility” and *Kridl v. McCormick*, 41 U.S.P.Q.2d 1686, 1690, Fed. Cir., 1997).

Thus, Jaana Nopola-Hemmi and Nina Kaminen, having made inventive contributions to the presently claimed invention, are rightly named as Inventors herein, however they are also correctly not named as co-authors of the Taipale et al. reference.

Additionally, Applicants assert that conception of the presently claimed invention was completed before the effective date of the Taipale et al. reference, though the contribution of Jaana Nopola-Hemmi and Nina Kaminen to the conception of the present invention is not reflected in the Taipale et al. reference. (*See, Declaration, at paragraph 6, last sentence*).

Thus, the Taipale et al. reference having been antedated herein to the extent of that which is disclosed in the Taipale et al. reference, Applicants assert that the Taipale et al. reference is not prior art with respect to the present application.

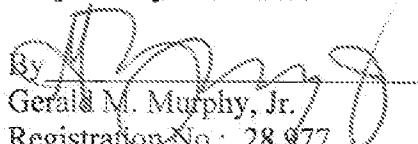
Applicants believe the above clarifications fully address all outstanding rejections based on the Taipale et al. disclosure. Thus, reconsideration and withdrawal of these rejections (based on anticipation) are respectfully requested.

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: April 20, 2007

Respectfully submitted,

  
Gerald M. Murphy, Jr.  
Registration No.: 28,977  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicants

Attachments: Declaration under 37 C.F.R. § 1.131 (6 pages),  
4 individually executed signature pages



Docket No.: 0933-0214P  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Juha KERE et al.

Application No.: 10/681,199

Confirmation No.: 9233

Filed: October 9, 2003

Art Unit: 1634

For: NOVEL HUMAN GENE FUNCTIONALLY  
RELATED TO DYSLEXIA

Examiner: J. A. Goldberg

DECLARATION UNDER 37 C.F.R. § 1.131

Honorable Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

1. We, Juha Kere, Mikko Taipale, Jaana Nopola-Hannula and Nina Kainulan, declare as follows:
2. We are the listed inventors of the subject matter disclosed and claimed in the above-identified U.S. Patent application and we are familiar with the prosecution history of the application.
3. We understand that the Examiner has made a rejection of the claims over Taipale et al., GenBank Accession Number AF337549, February 2, 2002. It is our understanding that Taipale et al. is effective as a reference as of February 2, 2002.
4. The Taipale et al. reference lists as authors Taipale, M. and Kere, J. These co-authors of Taipale et al. are the same persons as the inventors Juha Kere and Mikko Taipale.
5. Applicants understood that the Taipale et al. reference discloses the sequence of

Application No. 10/681,199  
Declaration Under 37 C.F.R. § 1.131  
Reply to Office Action of April 24, 2006

Docket No.: 0933-0214P

SEQ ID NO:1, claimed in the present application.

6. Co-Inventors Juha Kere and Mikko Taipale are responsible for discovering the DYXCI gene, presently claimed as SEQ ID NO:1. Co-Inventors Jaana Nopola-Hemmi and Nina Kaminen contributed to conception of the present invention in helping to determine utility of the present invention by discovering, together with co-inventors Juha Kere and Mikko Taipale, that the DYXCI gene plays a role in dyslexia. The Applicants conceived of the utility of the invention before February 2, 2002.

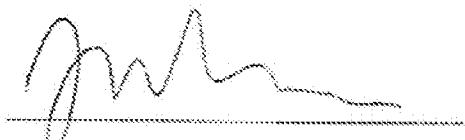
7. Therefore, although Jaana Nopola-Hemmi and Nina Kaminen are not co-authors of the Taipale et al. reference, they are indeed co-inventors pertaining to the subject matter encompassed by the presently claimed invention.

Application No. 10/681,199  
Declaration Under 37 C.F.R. § 1.131  
Reply to Office Action of April 24, 2006.

Docket No.: 0933-0214P

## Statement Under 18 U.S.C. § 1001

I hereby declare that all statements made herein of my own knowledge are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Signed/ Juha Kere



Date

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Signed/ Mikko Taipale

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Date

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Signed/ Jaana Nopola-Hemami

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Date

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Signed/ Nina Kämänen

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Date

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Submitted Under 18 U.S.C. § 1001

I hereby declare that all statements made herein of my own knowledge are believed to be true, and further that false statements were made with the knowledge that such false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the safety of the parties whom I have named above.

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**Statement Under 18 U.S.C. § 1001**

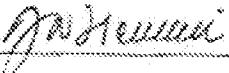
I hereby declare that all statements made herein of my own knowledge are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signed/ John Kere

Date

Signed/ Mikko Taipale

Date

  
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Signed/ Joana Nopala-Hennem

Date

Signed/ Nina Kamrin

Date

Application No. 10/681,199  
Declaration Under 37 C.F.R. § 1.131  
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Signed/ Juha Kere

Date

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Signed/ Mikko Taipale

Date

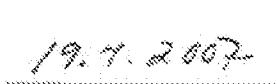
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Signed/ Jaana Nopola-Herunen

Date

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Signed/ Nina Kämänen - Ando

  
19.7.2007

Date